

III. Remarks

A. Status of the Claims

Claims 1 and 8 are amended. Claims 1-16 are pending.

B. Supplemental Information Disclosure Statement Mailed May 10, 2004

A Supplemental Information Disclosure Statement was mailed to the Office on May 10, 2004. Applicants respectfully request that the Examiner review the Statement and make references listed therein of record in the present application.

C. Defective Oath or Declaration

The Office Action alleges that the declaration is defective because it does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

Response

Applicants respectfully submit that the original declaration is not defective. The original declaration as filed states "I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37 Code of Federal Regulations §1.56." As stated by a Patent Specialist at the Patent Legal Administration Office of the U.S. Patent and Trademark Office in a telephone conversation with the undersigned on May 11, 2004, the pre-1992 standard of "material to examination" is broader than the post-1992 standard of "material to patentability." Thus, rather than being defective, the original declaration was fully in compliance with 37 CFR §1.63(b)(3) because the disclosure obligation acknowledged in the declaration called for the disclosure of more information than required by the prevailing standard. Accordingly, the characterization of the original declaration as being defective and the requirement for a new declaration should both be withdrawn.

Regardless of the merits of the original declaration, however, Applicants submit herewith a Supplemental Declaration (Attachment A) so as to correct the technical defect in the form of the declaration. The Supplemental Declaration is signed by the three co-inventors, identifies the application by application number and filing date, and states that the persons making the declaration acknowledge the duty to disclose information which is material to the patentability of the application in accordance with 37 CFR §1.56.

For all of the foregoing reasons, Applicants respectfully request that the requirement for a new declaration be withdrawn.

D. Rejection of Claims 1-6 and 9-16 for Obviousness-type Double Patenting over Claims 1-41 of U.S. Patent No. 6,362,207, and Rejection of Claims 1-6, 9-12, and 15-16 over Claims 9-20 of U.S. Application No. 09/703,955.

Claims 1-6 and 9-16 were rejected as unpatentable over Claims 1-41 of U.S. Patent No. 6,362,207. Claims 1-6, 9-12, and 15-16 were rejected as unpatentable over Claims 9-20 of U.S. Application No. 09/703,955.

Response

The present application and the '207 patent are commonly owned by UAF Technologies and Research, LLC. by virtue of the attached following documents:

Present application (USSN 10/634,542): Attachment B provides a copy of the assignment from the University of Arizona Foundation to UAF Technologies and Research, LLC. The assignment was filed with the Patent Office on October 20, 2003 and was recorded at Reel 014051/, Frame 0993. The citation of this application is on page 2, entry no. 9, of the recordation document.

U.S. 6,362,207 (USSN 09/748,651): Attachment C provides a copy of the assignment from the University of Arizona Foundation to UAF Technologies and Research, LLC. The assignment was filed with the Patent Office on October 20, 2003 and was recorded at Reel 014051/, Frame 0993. The citation of this application is on page 3, entry no. 4, of the recordation document.

Provided herewith as Attachment D is a terminal disclaimer over the '207 patent. The filing of a terminal disclaimer is understood to simply serve the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.

U.S. Application No. 09/703,955 is no longer pending as evidenced by the Notice of Abandonment for that application provided for the convenience of the examiner as Attachment E. The continuation case U.S. Application No. 10/280,100 is also closed. The Notice of Abandonment for the continuation case is also provided as Attachment E.

Applicants respectfully request that these rejections be withdrawn.

E. Rejection of Claims 1, 7, and 8-12 under 35 USC § 102b
Office Action

The Office Action states a rejection of Claims 1, 7, and 8-12 as anticipated by Paget *et al.*, *J. Med. Chem.* 12:1010-1015, 1969.

Response

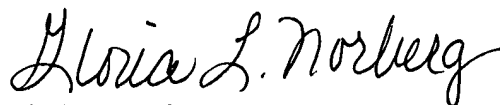
For a prior art reference to anticipate a claim, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Benzimidazoles having substituents as claimed in Claims 1, 7, and 8-12 are not disclosed in the cited reference.

Applicants therefore respectfully request that this rejection be withdrawn.

F. Conclusion

The present paper is believed to be a complete response to the Official Action mailed April 2, 2004. Reconsideration is respectfully requested. Should this response be considered inadequate or non-responsive for any reason, or should the Examiner have any questions, comments or suggestions that would expedite the prosecution of the present case to allowance, Applicant's undersigned representative earnestly requests a telephone conference at (512) 867-8528.

Respectfully submitted,



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Date: June 29, 2004

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